

**REMARKS**

Claims 1-64 were pending in the present application. Claims 3, 5, 7, 10, 16, 28, 40-55 and 58-64 were withdrawn from consideration. By virtue of this response, claims 4, 27, 56, and 57 have been cancelled, claims 1, 8, 11, 26, and 29 have been amended, and new claims 65-73 have been added. Support for the amendments made in claims 1, 8, 11, 26, and 29 can be found throughout the specification, for example, at [0030], [0032], and [0066] of the published version of the specification (US 2004/0214162). Support for new claims 65-73 can be found at [0083], [0140], and [0168]-[0176]. Accordingly, claims 1, 2, 6, 8, 9, 11-15, 17-26, 29-39, and 65-73 are currently under consideration.

Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

***Claim Objections***

Claims 4 and 27 are objected to under 37 CFR 1.75(c) as being of improper dependent claim form. Claims 4 and 27 have been canceled, thus rendering the objection moot.

***Rejections under 35 U.S.C. §112***

Claims 29-32 are rejected under 35 U.S.C. §112, first paragraph as allegedly being non-enabling for a host cell comprised within a living organism such as transgenic animal or human. The Examiner notes at the bottom of page 5 of the Office Action that amendment of claims to “isolated host cell” would overcome the rejection.

Accordingly, for the purposes of expediting prosecution, Applicant has amended claim 29 to recite “isolated host cell.” Support for this amendment can be found at [0081] and [0159]. Since claims 30-32 depend on claim 29, they would also incorporate this limitation as well.

As such, Applicant respectfully requests that the Examiner withdraw this rejection for

claims 29-32.

*Rejections under 35 U.S.C. §112*

Claims 26, 27, 30, 32, 34, 36, 38, 39 and 57 are rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement because the recombinant PAV vectors, when read broadly, allegedly encompass inoperative embodiments.

Applicant respectfully disagrees with the Examiner's position that previously submitted claim 26 encompassed inoperative embodiments. However, for the sake of expediting prosecution, claim 26 has been amended to provide requirement the recombinant porcine adenovirus vector comprise an isolated porcine adenovirus sequences essential for encapsidation, wherein the sequences essential for encapsidation are nucleotides 212-531 of the porcine adenovirus type 3 (PAV3). Support for this amendment can be found throughout the specification, e.g., at [0030], [0032], and [0066]. With the addition of this requirement, the claim is further clarified and does not encompass any inoperative embodiments. Claims 27 and 57 are canceled, thus rendering the rejection for these claims a moot point.

As such, Applicant respectfully requests that the Examiner withdraw this rejection for claims 26, 30, 32, 34, 36, 38, and 39.

*Rejections under 35 U.S.C. §112*

Claims 56 and 57 are rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement.

Without acquiescing to the rejection and for the purpose of expediting prosecution, Applicant has canceled claims 56 and 57, thus rendering this rejection moot. As such, Applicant respectfully requests that the Examiner withdraw this rejection for claims 56 and 57.

*Rejections under 35 U.S.C. §102(a)*

Claims 1 and 4 are rejected under 35 U.S. C. 102(a) as being allegedly anticipated by Nielsen et al. (US Patent No. 6,350,853). The Examiner's position that that the Nielsen reference discloses a sequence of 10 nucleotides that contains TATTTTTT (SEQ ID NO:4).

Applicant respectfully disagrees with the Examiner. The Nielsen reference is directed to peptide nucleic acids which are composed of naturally-occurring nucleobases or non-naturally occurring nucleobases that are covalently linked to a polyamide backbone (see col. 1, lines 16-18). More specifically, Example 26 (col. 26 starting at line 44) discloses the synthesis of SEQ ID NO: 4. Example 26 describes the solid phase synthesis of H-Taeg-Aeg-[Taeg]<sub>8</sub>-Lys-NH<sub>2</sub> (which is disclosed as SEQ ID NO:4). This H-Taeg-Aeg-[Taeg]<sub>8</sub>-Lys-NH<sub>2</sub> is not the same as what was being claimed in claims 1 and 4. However, for the purposes of clarifying the invention, claim 1 has been amended to recite an additional limitation of containing the entire encapsidation sequence (nt 212-51) of PAV3. This element is not taught in the Nielsen reference. As such, the Nielsen reference is not an anticipatory reference to claim 1. Claim 4 has been canceled, thus rendering this rejection moot.

As such, Applicant respectfully requests that the Examiner withdraw this rejection for claim 1.

*Rejections under 35 U.S.C. §102(b)*

Claims 1, 2, 4, 6, 8, 9, 11, 15, 17, 29, 31, 33, 35, 37, 38, 39, and 56 are rejected under 35 U.S.C. §102 (b) as allegedly being anticipated by Reddy et al. (WO 99/53047, "Reddy"). Examiner notes that the Reddy reference contains the entire PAV genome which inherently contains TATTTTTT.

Applicant respectfully disagrees with the Examiner's interpretation of the Reddy reference. At the time of the Reddy filing, the region of PAV3 that was responsible for encapsidation had not been fully elucidated nor were the motifs for the sequence required for

encapsulation known. The present application provides details down to the exact nucleotide residues that are essential for encapsidation which could not have been predicted with a full genomic sequence. However, for the sake of expediting prosecution, claim 1, 8, and 11 have been amended to require that the entire encapsidation region (nt 212-513) be present and that the encapsidation sequence *consists of* the nucleotide sequence between 212-513. Thus, the Reddy reference does not teach these elements and, as such, does not anticipate claims 1, 8 and 11 and the claims dependent thereon. Claims 4 and 56 have been canceled, thus rendering the rejection for these claims moot.

As such, Applicant respectfully requests that the Examiner withdraw this rejection for claims 1, 2, 6, 8, 9, 11, 15, 17, 29, 31, 33, 35, 37, 38, and 39.

***Double Patenting***

Claims 1, 2, 4, 6, 8, 9, 17, 20, 22-25, 29, 33, 35, 37, 39, and 56 are rejected under the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 13-17 and 19-23 of U.S. Patent No. 6,492,343.

Applicant respectfully requests that this rejection be held in abeyance until such time when allowable subject matter has been determined.

**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no.

**293102003600**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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